

REMARKS/ARGUMENTS

This Amendment and Response is promptly filed to place the above-referenced case in condition for immediate allowance.

The status of the claims is as follows:

Cancelled: 9 - 11 and 13;

Amended: 12, 14, 17, 19, 21, 22, 25, and 26;

Added: 29 - 92; and

Currently outstanding: 1 - 8, 12, 14 - 92.

No new matter has been added to the application.

From the outstanding Office action: The Examiner rejected Claims 1 - 4 and 13 -15 under 35 U.S.C. 101; and Claims 1 - 8 and 12 - 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Hall et al. '375 patent in view of the Stevens '758 patent.

Reconsideration is respectfully requested.

Applicant confirms the provisional election made on or about October 6, 2004 but does not recall any renumbering of the claims. As set forth below, and as emphasized by the underlined, the original number of the claims must be preserved throughout the prosecution.

Applicant has proceeded in this Reply along the lines set forth in the rule. Consequently, claim 13 has been preserved as a cancelled claim and the renumbering is with the prior claims 14 through 28 and new claims 29 - 92.

Applicant welcomes further instruction with regards to this matter, but understands that rule 126 controls with respect to the procedure regarding the numbering of claims and how that numbering is pursued during the prosecution of an application.

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997] (emphasis added)

Applicant has amended the specification without introducing new matter. If the Examiner is aware of additional minor errors, he is invited to inform Applicant of same. Applicant's review found only very few minor errors.

The Examiner rejected claims 1 – 4 and 13 – 15 under 35 U.S.C. 101. The Examiner indicated that the claims' subject matter is directed to non-statutory subject matter.

Applicant believes that the current state of the law with respect to statutory subject matter is controlled by the State Street case (State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368; 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998)). Additionally, MPEP § 2106 deals with patentable subject matter with regards to computer related inventions as well as giving an overview to patentable subject matter.

Applicant notes that his claims are directed to a method of scheduling and delivery of an ordered product and includes the dispatching of a portable locker station to the pickup point, the pickup point being generally determined by the route information supplied by a buyer. Nothing in claim 1, or in any of the other claims rejected under 35 U.S.C. § 101, appear to be outside the scope of patentable subject matter which explicitly includes methods. The Examiner may want to note that the two applications that were cited against the present application include method claims in a form much like those set forth in Applicant's application as amended. Applicant believes that his claims are just as patentable as those claims in the Stevens '758 and Hall et al. '375 patents as well as being clearly patentable subject matter under 35 U.S.C. § 101.

Applicant invites the Examiner to contact the undersigned with regards to the statutory nature of the subject matter should further discussion be warranted. Applicant believes that his claims all set forth subject matter that is patentable under 35 U.S.C. § 101. Applicant also notes that both the In re Alappat and the AT&T v. Excel cases (cited by the Examiner) reached the conclusion of patentable subject matter by the Court of Appeals for the Federal Circuit. The Examiner's attention is directed towards MPEP § 2106 (II)(A).

The Examiner rejected claims 1 – 8 and 12 – 27 under 35 U.S.C. § 103(a) as being unpatentable under the Hall et al. '375 in view of the Stevens '758 patent.

The Hall et al. '375 patent (the "Hall patent") aims at scheduling a local facility to satisfy the order placed by a mobile customer. Hall's patent uses GPS or other similar technology to determine the mobile consumer's current location. The server then tracks the consumer's movement, may possibly determine the user's traveling speed, locates a local facility, estimates the arrival time of the user to the local facility, estimates the preparation time of the facility for the

order, as well as the inventory level and production capacity of the facility and uses this information to determine a local facility to produce the user's order. Once the optimal local facility is obtained by using these information, the order is placed at that local facility and user will go to that local facility to pick up the order without having to wait as long for the order once the user arrives at the facility.

While Applicant's technology also determines a user order pick up point for the user to pick up his/her order, fundamental differences exist in Applicant's model and Hall's model in the way order pick up point is determined. The Hall '375 patent uses the following parameters to determine a user order pick up location (facility): current location of the user, the travel speed of the user, location of the facility, estimated arrival time of the user to the facility, validity of inventory/production capacity of that facility and the estimated time required by the facility to process the order.

Applicant's system uses a travel route as parameter to determine a user order pick up location. Current location of the user, the travel speed of the user, location of the facility, estimated arrival time of the user to the facility, validity of inventory/production capacity of that facility and the estimated time required by the facility to process the order, which are essential in the Hall '375 patent, are all irrelevant in Applicant's system.

In Applicant's system, a pickup location is determined by user travel route and a travel route is determined by the beginning route identifier and end route identifier provided by the user. The exemplary identifiers are: address zip code, telephone number, landmark, city name...etc. The user has the option to use a channel of selected width to define the distance a user is willing

to travel out of the route to pick up order. In a plural user situation, Applicant's system uses route overlapping to maximize pick up location selection efficiency.

Consider the following scenario: in the Hall '375 patent system, suppose a user travels eastwards on San Gabriel Blvd with a speed of 30 miles per hour and will turn right on Garvey Ave as the user's usual travel route. Before he/she turns on Garvey, the server detects the user's travel speed, and travel direction. Because the server does not know the user will turn on Garvey, the server may arrange a pick up facility that is along San Gabriel Blvd. but further east to Garvey. This will certainly cause extra travel for the user because the pick up facility is not along the user's travel route. To reach the maximum convenience for a user to pick up order, a system needs to establish a user's travel route. In the Hall '375 patent, there is no teaching as how to establish a user travel route as all information is spontaneous and is not pre-selected.

The only teaching in Hall's invention with regards to the concept of user travel route appears in one sentence only. See the Hall '375 patent at col. 9 lines 27-30:

"Preferably, the local facility is the facility nearest geographically to the customer's location at the time of the order or a facility that is convenient to the customer's planned travel route, such as on the way home from work."

Nowhere does the Hall '375 patent suggest anything about how a user may establish a travel route. To establish a user travel route, the server must provide to the user a system which allows the user to identify the beginning and the end of the user's travel route. The server then uses this beginning and end route information to build the user's travel route. The exemplary identifiers disclosed in the present application are address, zip code, city name, landmark... etc. Because a beginning route identifier and an end route identifier may define many, many different

travel routes and lots of these routes may not be practical to the user to use, an ideal system must allow, as disclosed in the present application, the user to select the user's preferred travel route. The Hall '375 patent teaches nothing with regards to building a travel route.

Another difference in the present application and the Hall '375 patent is that in Applicant's system, orders may be delivered by using Mobile Pick Up Stations (MPSs). An MPS may be a truck, a movable kiosk or a movable locker. An MPS is mobile in nature. The server dispatches an MPS which carries user orders and parks the MPS at a pick up location for a determined period of time waiting for a user to pick up his/her order. A pick up location can be anywhere, such as a wide open street, a parking lot, a gas station or cross of streets. A user under Applicant's system travels to the pick up location and picks up the order at the MPS.

In contrast, a user under the Hall '375 patent system travels to a local facility to pick up his/her order. Nothing in the Hall system suggests that the local facility may be mobile. In the Hall '375 patent, col. 8, line 25-29, Hall states "... The data base may include information about the facility such as address, telephone number..." which indicates that the facility is a fixed structure and not mobile. Further, no mention is ever made in the Hall '375 patent of the facility going to the user. The Examiner, in his comments, notices this. See the last sentence of page 5 of Examiner's Action with respect to Hall et al. not disclosing such dispatchment of a portable locker.

In Applicant's system, a mobile pick up station is mobile and the pick up location can be any place with or without address. A typical MPS parks at a pick up location for a determined time and leaves when the time is up.

Also, in the Hall '375 patent, a user is "a customer in a mobile environment" (see at least col. 1, line 8; col. 2, line 27; and col. 5, line 45). A user under the Hall et al '375 patent places the order and receives pick up location information as the user is traveling. The user does not know where to pick up his/her order before he/she travels and can not plan his/her travel plan conveniently. By contrast, a user under Applicant's system knows his/her pick up location beforehand and may plan his/her travel plan, e.g., to run other errand, to pick up orders from other vendors...etc, more efficiently.

The Examiner states that the Hall patent provides service to customers "in a mobile environment". This is exactly the reason why the Hall patent needs parameters such as the user's current location, travel speed, travel direction and the distance between the user's current location to server facility to determine the location of pick up facility. In contrast, Applicant's system does not deal with customers "in a mobile environment" like that in the Hall patent. Among the parameters used to determine user's pick up location in Applicant's system is the user's selected travel route. The travel route is determined by the user's input of the beginning and the end of travel route. The parameters used in the Hall patent are irrelevant in Applicant's system and vice versa.

The Examiner indicates that the Hall patent has "receiving mobile customer location information using global positioning system (GPS); tracking customer's route to estimate time of arrival (see at least col. 2, lines 12-61; col. 5, lines 5-65)".

In Applicant's system, the travel route is pre-determined by designation of the beginning and the end of travel route. As stated in above, Applicant's system does not use parameters such as the user's current location and travel speed, direction and the distance of the user's current

location to a facility to determine a pick up location. Instead, in Applicant's system, the user order stays at a pick up location for a predetermined period of time, e.g., 5 p.m. to 8 p.m., waiting for the user to pick it up. The user may come to the pick up location during the period of time to pick up the order. In Applicant's system, use of GPS or otherwise to determine a user's current location and the tracking of the customer's route to estimate the time of arrival is unnecessary.

The Examiner indicated that, "determining the location of a facility that best fits the needs of the mobile customer" (see at least col. 2, lines 40-61; col. 5, lines 5-65) corresponds to Applicant's claimed selection method for the pick up point.

In the Hall patent, the pick up point that "best fits the needs of the mobile customer" is selected by using the following parameters: the consumer's current location, traveling speed, location of a local facility, estimate of the arrival time of the user to the local facility, estimate of the preparation time of the facility for the order, and the inventory level and production capacity of the facility. In contrast, Applicant's system does not deal with customers "in a mobile environment". The parameters Applicant's system uses to determine user's best pick up location is the user's selected travel route. The travel route is generally determined by the user input of beginning and end of travel route.

The Examiner's comment regarding the references points of telephone number and geographic location in the Hall patent (see at least col. 6, lines 30-35) are not on point with respect to Applicant's claims.

The only time the term "telephone number" is mentioned in the Hall patent is at col. 8, line 27 of the Hall patent, which is the telephone number of a facility. The telephone number as stated is obviously for use in the facility's daily operation and has nothing to do with the selecting of pick

up facility. The telephone number the Examiner refers to in this comment may instead be a “telephone system that determines the customer’s location from a telephone call” (col. 6, lines 30 - 33), the function of which is the same as the function of a GPS system, to determine the user’s current location.

In Applicant’s system, a “reference point” whether it is a phone number, an address or a zip code, is used to define an area in which pick up location is selected. It is nothing to do with the user’s current location as used in the Hall patent.

The Examiner indicated that, “Hall teaches all the above as noted under the 103(a) rejection and teaches a) directing a mobile customer to the nearest facility that can provide a service using GPS...”

The Hall patent system has to use GPS or a similar technology to work. That is not true in Applicant’s system as while the Hall patent system finds a “nearest facility” to the mobile user’s current location, Applicant’s system finds the best location close to a user’s travel route. Significant differences exists between the two of which one is the fact that the Hall system is useful for spontaneous purchases while Applicant’s system is useful for the regular delivery of goods.

The Examiner also indicated that “b) busy people seeking ways to save time....., c) technology designed to reduce the amount..., d). today’s consumer increasingly....that promises the quickest time (see at least [Hall,] col. 1, lines 33-38)”. All these comments are descriptions of the problems the Hall patent tries to solve. Applicant’s system solves these problems in a different way.

The Examiner indicates that, “and e) preferably, the local facility is the facility nearest geographically to the consumer’s location at the time of the order...”

In doing so, the Examiner points out a basic difference between the Hall patent and Applicant's system. The Hall patent finds the best local facility that is the facility nearest geographically to the consumer's location at the time of the order. Applicant's system finds the best pick up location according to a user's travel route.

The Examiner also indicates, "or a facility that is convenient to the customer's planned travel route, such as on the way home from work (please note Examiner's interpretation: channel width of a commuting route)(see at least col. 9, lines 26-31). In fact, the Hall patent never clearly defines a travel route which reinforces the example given above with respect to travel along San Gabriel Blvd. and Garvey Ave. Without a clear definition of a route, there is no way the Hall system can build a channel as in Applicant's system.

The Stevens '758 patent (the "Stevens patent") cited by the Examiner uses a position, or location, code to define the location of a locker box. A delivery agent delivers a user order bearing the position code to the appropriate box and uses a wireless key to open the locker box. The delivery agent puts the order in the box and locks the locker. The user then opens the box with a key to receive the order.

The Examiner's states that, "Stevens teaches a package storage and delivery system that provides stackable lockers deliver to pick up point and delivering additional locker(s) if delivery do not fit into a single locker...Stevens teaches these portable lockers being placed..."

The Examiner regards the Stevens locker as "portable" by reference to col. 1, line 20-23 of the Stevens patent where it states that, "The locker may be stackable, permitting a delivery courier to add lockers in the event a customer receives too many deliveries to fit into a single locker."

The Examiner cites the portable function in Stevens to reject Applicant's claims. But the "portable function" in Applicant's portable locker (or Mobile Pickup Station) is not the same as the "portable function" in Stevens patent. The Examiner mistakenly regards the Stevens's patent "portable" function the same as the "portable" function in Yang's MPS locker.

In Stevens patent model, there is at least one locker that is installed at the user's premises. The location of a Stevens locker is determined at the time of installation by a device such as a GPS receiver. The location of the locker is expressed by using a location code. The delivery courier transports user's package and, finds the locker by its location code. The delivery courier opens the locker and deposits the user's order into the locker. Later, the user opens the box and retrieves his/her order. When a delivery person arrives at the user's locker and notices that the user locker is not sufficient to fit the user's order, the delivery person presents a "stackable locker" to fit user order. The Examiner may regard the "stackable" function as "portable". In fact, the "stackable locker" is a back up storage device used to fit user order in case the installed locker is not sufficient to fit user order.

By contrast, a "portable" locker (or Mobile Pick Up Station) in Applicant's system may be transportation equipment. A "portable" locker (or a MPS) is loaded with user orders in the MPS warehouse and is dispatched from the warehouse to a pick up location and stays there for a determined period of time waiting for user's arrival. The MPS or portable locker is then dispatched back to a MPS warehouse for reloading when the station time is up.

The Applicant's "portable" locker (or a MPS station) is substantially different from Stevens' box even if a "stackable box" is involved, because a) at least one Stevens box is installed

at user premise, typically attached to a home, and b) all Stevens boxes (includes a “stackable box”) are used for the receiving of orders only.

The Examiner indicates that the Stevens portable lockers are: “located using GPS and positioning these [lockers] along locations determined by the system or by the customer’s commuting route (e.g., customer’s home)”

The use of GPS is essential both in Stevens and Hall systems, but is irrelevant in Applicant’s system. The concept of a “commuting route” or similar route concept never appears in the Stevens patent, although this concept is important in Applicant’s system. Although in Stevens, a locker box may be installed in a user’s home, it is not the same as to dispatch a MPS to a user’s travel route. The Examiner is in error to equate a customer’s home to the customer’s commuting route.

Overall, the Hall and Stevens patents do not teach many functions of Applicant’s system. Additionally, there is no justification in combining these two, as set forth in more detail below.

All of this is reflected in Applicant’s claims, which seek to protect subject matter that is not set forth in neither the Hall patent, the Stevens patent, nor the combination thereof.

As an example, claim 1 requires that a reception occurs of route information from a buyer. Only location information is transmitted by the GPS unit in the Hall patent. Furthermore, the route that can be formulated with certainty in the Hall patent is one that is retrospective and not prospective in nature. This is an important point because the Hall patent only dwells upon what has happened in the past up to the user’s current location and not what will happen in the future. That is, the Hall patent can only formulate a user’s travel route with certainty from the point the user logs on to the server’s system to the user’s present location. Any travel route that is beyond

the user's current location is uncertain to and is of speculation of the server. Accordingly, the Hall patent cannot effectively select a plurality of pick up points based on the route because the route that is present in the Hall patent is only that which has occurred in the past and which the user/buyer is leaving behind. The uncertainty of a user's prospective travel route and the inability to formulate and use the complete user travel route in the Hall patent create inefficiency as is illustrated in the San Gabriel Blvd. example discussed above.

In Applicant's claim 1, the route is one that is a complete user travel route with certainty to the server and one that the user can proceed towards in order to pick up his package. Finally, the Hall patent does not disclose any dispatchment of any a portable locker station, only the installation of facilities that are fixed in nature. No portable locker station is disclosed and the presence of a portable locker station (for argument only) in the Stevens patent does nothing to remedy the short comings in the Hall patent. Of necessity, the point on the route that the portable locker station would be placed in a Hall-Stevens combination would be on some point that the server speculates the user will go to, not to one that the user will go to for certain in the future.

As a result, claim 1 is neither anticipated nor made obvious by either the Hall or the Stevens patents, or any reasonable combination thereof. The same is similarly true for the claims that depend upon claim 1, namely claims 2 – 4 and 12 – 16. As these claims all incorporate the subject matter of claim 1 and as claim 1 is patentable over Hall and Stevens, the claims that depend upon claim 1 are also patentable over the Hall-Stevens combination.

The same is similarly true for the remaining independent claims, namely claims 5, 21, 25, 37, 46, 55, 64, 73, and 83. All of these claims incorporate route information that is a prospective route, and not a server-speculated one, taken by the user/buyer. As a result, the Hall-Stevens

combination cannot anticipate or make obvious this perspective route combination as the real-time tracking present in these systems defeats the ability to predict what route the user/buyer will take. Only the user/buyer knows that and the tracking system used in the Hall et al. and Stevens patents does not transmit or use this information. Applicant's claims each require the selection of the pick up point, but not one that lies in the path that is speculated by the server, but one that the user/buyer will encounter in the future.

From the foregoing, it can be seen that Applicant believes that there are a plurality of grounds upon which the rejection to of the claims would be and is overcome. Applicant also believes that, for similar reasons, there is no teaching or motivation to combine Hall et al. with Stevens. In the recent past, the Court of Appeals for the Federal Circuit has spoken on this matter.

The Court of Appeals for the Federal Circuit (CAFC) has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. In the present case, there is no disclosure or suggestion in any of the references relied on by the Examiner from which the locker mobile pickup station system claimed by Applicant may be constructed. Indeed, even in light of Applicant's own teaching, the Examiner has been unable to reconstruct from the cited references a locker mobile pickup system which meets the language of the present claims.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an applicant's claims are obvious. Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988). The CAFC has indicated that two questions are to be asked when a combination of references is relied upon to reject a claim:

- (1) whether a combination of the teachings of the references would have suggested (expressly or by implication) the possibility of achieving further improvement along the lines of the claimed invention; and
- (2) whether the claimed invention has achieved more than a combination which any or all of the prior art references suggested.

In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

The Court emphasized that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining these teachings. Something more than merely finding each element of the combination in the references is required, and here the Examiner has not even found that.

Applicant submits the Examiner has failed to demonstrate that the answer to either question should be decided against Applicants. None of the references, alone or in combination, disclose or suggest the combination of elements recited in Applicant's present claims. As such, Applicant's Claims all go beyond that which has been achieved before and are not reflected by any reasonable combination of the prior art references.

Further, the Examiner has pointed to nothing in any of the references that suggests combining their teachings. A reading of each of the references uncovers no suggestion or teaching in any of them as to the advantages to be gained by having a route-determined pickup system as only a retrospective and real-time system arises from the Hall and Stevens patents. The Examiner has unsuccessfully tried to pull from the cited references specific elements claimed by

Applicant, based on Applicant's own teaching and not on those teachings set forth in the cited references.

Finally, the subject matter of the invention as a whole must be considered. Even though features may be disclosed in the prior art, performing their ordained and expected function, the test is whether the claimed invention as a whole, in light of all of the teaching of the references in their entireties, would have been obvious to one of ordinary skill in the art. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). Thus, it is clear that, in light of decisions of the CAFC, the Examiner has not met the CAFC's tests in combining references.

A reference is only good for what it clearly and definitely discloses. In re Moreton, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961); In re Hughes, 345 F.2d 184, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965). Furthermore, a patent is not a fair reference where it is not directed to the same purpose and does not involve the same inventive concept. Ex parte Garvey, 41 U.S.P.Q. 583 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1939). Absent a clear disclosure, i.e., an anticipation or some other special statutory prohibition, a rejection must stand or fall on the existence of obviousness as qualified in 35 U.S.C. § 103. In re Murray et al., 268 F.2d 226, 122 U.S.P.Q. 364, 367 (C.C.P.A. 1959).

It is submitted that the claims under discussion are not anticipated or obvious in view of the references made of record and the references relied upon by the Examiner in the rejections. The claims patently define over each of the references, either individually or taken in any reasonable combination.

A combination of references is improperly applied where there is no suggestion by any of the references of the problem involved or where the solution to the problem is neither indicated nor taught. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956). When references are combined, it should be considered whether the references suggest a thing which the applicant has done. In re Gruskin, 234 F.2d 493, 110 U.S.P.Q. 288, 292 (C.C.P.A. 1956). Moreover, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the applicant's claims. In re Hortman, 264 F.2d 911, 121 U.S.P.Q. 218, 220 (C.C.P.A. 1959); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); see also Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988).

Whether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art. In re Free, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964); In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). What the Examiner is attempting is a piecemeal construction of the prior art in view of the Applicant's own disclosure in order to negate the present invention. The law clearly does not sanction this procedure. In re Rothermel et al., 276 F.2d 393, 125 U.S.P.Q. 328, 331 (C.C.P.A. 1960); In re Kamm & Young, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972); W. L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

As the CAFC has stated in Environmental Designs, Ltd. et al. v. Union Oil of Cal. et al.;

"Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art . . . "

713 F.2d 693, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983), cert. denied, 104 S. Ct. 709, 224 U.S.P.Q. 520 (1984).

The CAFC has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. There is no teaching or suggestion in either the Hall et al. or Stevens references relied on by the Examiner from which the invention claimed by Applicant can be constructed. In In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) the Federal Circuit Court stated:

. . . a retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which supports selection and use of the various elements in particular claimed combination. . . .

It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art.

See also, accord, In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

From the foregoing remarks, Applicant's claims are all is believed to be patentable over Hall et al. in view of Stevens.

Furthermore, in light of the Manual of Patent Examining Procedure (MPEP), particularly § 2143.01, a suggestion or motivation must be present in order to combine references for purposes of obviousness.

Importantly, the prior art must suggest the desirability of the claimed invention.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). None of these situations exist in the present combination of Hall et al. and Stevens.

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved

as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In Ruiz v. A.B. Chance Co., 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), the patent claimed underpinning a slumping building foundation using a screw anchor attached to the foundation by a metal bracket. One prior art reference taught a screw anchor with a concrete bracket, and a second prior art reference disclosed a pier anchor with a metal bracket. The court found motivation to combine the references to arrive at the claimed invention in the “nature of the problem to be solved” because each reference was directed “to precisely the same problem of underpinning slumping foundations.” Id. at 1276, 69 USPQ2d at 1690. The court also rejected the notion that “an express written motivation to combine must appear in prior art references....” Id. at 1276, 69 USPQ2d at 1690. However, it is apparent in Ruiz that a motivation to combine must still be present.

In In re Kotzab, the claims were drawn to an injection molding method using a single temperature sensor to control a plurality of flow control valves. The primary reference disclosed a multizone device having multiple sensors, each of which controlled an associated flow control valve, and also taught that one system may be used to control a number of valves. The court found that there was insufficient evidence to show that one system was the same as one sensor. While the control of multiple valves by a single sensor rather than by multiple sensors was a

“technologically simple concept,” there was no finding “as to the specific understanding or principle within the knowledge of the skilled artisan” that would have provided the motivation to use a single sensor as the system to control more than one valve. 217 F.3d at 1371, 55 USPQ2d at 1318.

In In re Fine, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of this conclusion and reversed.

In In re Jones, the claimed invention was the 2-(2 α -aminoethoxy) ethanol salt of dicamba, a compound with herbicidal activity. The primary reference disclosed inter alia the substituted ammonium salts of dicamba as herbicides, however the reference did not specifically teach the claimed salt. Secondary references teaching the amine portion of the salt were directed to shampoo additives and a byproduct of the production of morpholine. The court found there was no suggestion to combine these references to arrive at the claimed invention.

The fact that references can be combined or modified is not sufficient to establish prima facie obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re

Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness.

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the

claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

The proposed modification cannot change the principle of operation of a reference.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352.). In this case, the Hall et al. system uses the delay that a facility has in providing the requested goods. The addition of a portable locker delivery system to that delay is not considered or taught in either the Hall et al. or Stevens patent. This changes the principle of operation for the Hall patent as does the fact that the Hall et al. system uses only the user’s route in retrospect and not the user’s prospective route.

In the present case, there is no reason given in the present Office Action to support the proposed combination.

Furthermore, Applicant's technology as claimed produces new and unexpected results not achievable nor anticipated by the Hall and Stevens patents.

Even if Hall invention and Stevens inventions were to be combined, Applicant's technology has novel and unobvious features over the proposed combination. The combination of those two inventions misses at least four important elements in Applicant's system: 1). receiving route information from a buyer, the route information including beginning of route and end of route information; 2). generating a route by using the beginning and end route information; 3). selecting a pick up location based on the route generating by using the beginning and end route information; and 4) dispatching a mobile pick up station (or portable locker) to the pick up point, the pick up station (or portable locker) encloses the ordered product and is mobile in nature.

These novel features produce new and unexpected results not achievable and anticipated by Hall and Stevens, such as: enabling the use of pre-defined routes, pre-determination of the pickup location, greater ease of use, and MPS mobility.

In the Hall and Stevens patents, even if combined, the selection of the pick up facility depends on user's current location, traveling speed and other criteria as described before so that, no user travel route is pre-defined clearly. Without pre-defined user routes, the Hall and Stevens systems can not perform two important functions in Yang's model: overlapping and the use of channels.

For overlapping, Applicant's system may overlap all user travel routes and identify the overlapped section(s) of users' travel routes. Since the overlapped section(s) is the portion of

travel route commonly traveled through by all users, one delivery of all user orders to the overlapped section completes delivery to all users. The Hall and Stevens patents do not disclose such an overlapping feature. Even if they did, it is inoperable or impossible for the Hall and Stevens model to perform such overlapping. In the Hall and Stevens systems, selection of a pick up facility depends on the user's current location and traveling speed when order is placed, so, different users may be assigned to different facilities to pick up their orders even if they travel through exactly the same travel route. Overlapping becomes meaningless for these systems. Additionally, the Hall and Stevens patents never define a user travel route the server may use to overlap with. Applicant's system is therefore much more efficient than the Hall and Stevens systems due to economies of scale.

For the second function, the use of channels, Applicant's system allows the user to clearly define a channel. The channel defines a distance (out of a user's preferred travel route) the user is willing to travel to pick up his/her order. Applicant's system then selects a pickup location within this channel for the user to pick up his/her order. So, in Applicant's system, every pick up location selected is convenient to the user. The Hall and Stevens patents do not provide such a function. It is then possible that in a Hall and Stevens-based system, a user may pick up an order by traveling to a pick up location that is too far away for the user. Applicant's system is therefore much more convenient to users.

In Applicant's system, a pick up location is determined before the user travels. A user knows where to pick up his/her order beforehand and can more efficiently plan the user's commuting plan and or pickup orders from other vendors. In Hall's model, the pick up location

is determined "on the go", i.e., when the user is traveling. An efficient traveling plan to pick up other orders from other vendors or to run other errands is difficult and unpredictable.

The Hall and Stevens systems require determination of the user's current location, traveling speed, traveling direction, location of a local facility relative to the user's current location and current production capacity of a local facility as parameters for determination of the pick up location. The operation is much more complicated than in Applicant's system. Applicant's system is more economical in computer time and hardware investment

In one of the embodiments of Applicant's system, an MPS is mobile and can be dispatched to and park at any place. The Applicant's pick up station can be moved to a place that is closer to the user's travel route. This mobility feature is especially valuable when customer demographic information changes. In this case, the Applicant's MPS can just move to a new location to accommodate its customers. By contrast, Hall's pick up facility is a fixed structure. It would be costly to move to a new location if customer demographic information changes.

In another embodiment of Applicant's system, a pick up location can be a fixed structure such as a convenience store...etc. Even so, the unique features and the benefit of Applicant's system as listed above still apply.

Therefore, the Applicant's system is more efficient than Hall's system in providing a solution to the long felt need, that is, to receive an online order conveniently. Such greater efficiency in Applicant's system is present with respect to the Hall patent considered alone, in conjunction with the Stevens patent, or in any reasonable combination with the prior art. Applicant's claims are neither anticipated nor made obvious by the Hall patent, either alone or taken in any reasonable combination with the prior art.

The Examiner has also cited a number of patents and publications as pertinent to the presently claimed invention. Since none of these have been relied upon as a reference against Applicant's claims, no further comment is deemed necessary.

In view of the above, the Examiner is respectfully requested to reconsider his position in view of the remarks made herein and the structural distinctions now set forth. The Examiner's rejections of the outstanding claims are believed to no longer apply. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective references providing the basis for a contrary view.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at the number listed below.

With the above-referenced changes, it is believed that the application is in a condition for allowance; and Applicant respectfully requests the Examiner to pass the application on to

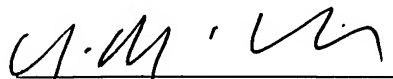
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allowance. It is not believed that any additional fees are due; however, in the event any additional fees are due, the Examiner is authorized to charge Applicant's Attorney's Deposit Account No. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP

Date: February 22, 2005


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Enclosures

Petition for Extension of Time - 1 Month
Acknowledgement Postcard

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Date